

TTAB

TRADEMARK
Ref. No.: 00630000105

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re application of:
Wintrust Financial Corporation

Serial No.: 75/935,479

Filed: February 17, 2000

Mark: NORTHBROOK BANK &
TRUST COMPANY

)
)
) Examining Attorney: B. Brown

) Law Office: 105
)
)

TRADEMARK TRIAL AND
APPEAL BOARD
AUG 14 AM 8:46

CERTIFICATE OF MAILING

I hereby certify that Applicant's Appeal Brief (with enclosure) is being deposited with the United States Postal Service as First Class Mail, postage pre-paid, on this date August 5, 2002, in an envelope addressed to:

Box TTAB - NO FEE
Assistant Commissioner for
Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Box TTAB - NO FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Michael J. Turgeon
Michael J. Turgeon, #39,404

August 5, 2002
Date

APPLICANT'S APPEAL BRIEF

I. INTRODUCTION

Applicant has appealed to the Trademark Trial and Appeal Board from the final decision of the United States Patent and Trademark Office Examining Attorney refusing registration of the above-referenced mark.

The Applicant filed its application to register the mark NORTHBROOK BANK & TRUST COMPANY on February 17, 2000. The Examining Attorney mailed his Final refusal on December 5, 2001. The Applicant noticed its appeal from that final rejection on June 5, 2002.



08-08-2002

U.S. Patent & TMO/TM Mail Rpt Dt. #79

The Examining Attorney has refused registration, contending that Applicant's mark so resembles the marks shown in U.S. Registration Nos. 1,265,418 for "Northbrook" for use in connection with insurance services and property and casualty loss control services; 1,679,641 for "Northbrook" for use in connection with commercial and liability insurance underwriting services and insurance consulting services; and 2,266,244 for "Northbrook" for use in connection with commercial and liability insurance administration services; underwriting and administration services in the field of life insurance; underwriting and administration services in the field of annuities, as to be likely to cause confusion, to cause mistake or to deceive in violation of Trademark Action §2(d), 15 U.S.C. §1052(d).

The above refusal is the only refusal outstanding in the pending application. All other matters having been resolved.

As set forth in the following sections of this appeal brief, Applicant believes the Examining Attorney's contentions to be in error and asks that this Board reverse his refusal and pass this mark to publication.

II. RELEVANT FACTS

Applicant filed its application to register the mark NORTHBROOK BANK & TRUST COMPANY for use in connection with banking services. Applicant provides its banking services to the public from a location based at 1100 Waukegan Road, Northbrook, Illinois 60062. Applicant has used the NORTHBROOK BANK & TRUST COMPANY mark in connection with providing bank services since on or before November 22, 2000.

III. ARGUMENT

Applicant respectfully submits that the mark NORTHBROOK BANK & TRUST COMPANY as used in connection with banking services does not resemble any U.S. Trademark Registration so as to be likely to cause confusion, mistake or to deceive. Therefore, the mark NORTHBROOK BANK & TRUST COMPANY is entitled to registration in the U.S. Patent and Trademark Office (the "USPTO").

This Trademark Trial and Appeal Board (the "TTAB") has repeatedly stated that when considering what factors are relevant to a determination of likelihood of confusion, it is helpful to turn to *In re E.I. Du Pont de Nemours & Co.*, 177 U.S.P.Q. 563 (C.C.P.A. 1973). In the instant application, the following *Du Pont* factors are most relevant in determining that there is no likelihood of confusion under § 2(d):

1. Dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;
2. The dissimilarity and nature of the services as described in the subject application with which a prior mark is in use;
3. The dissimilarity of established, likely-to-continue trade channels;
4. The conditions under which and buyers to whom sales are made, i.e., "impulse" vs. careful, sophisticated purchasing;
5. The lack of fame of the prior mark;

6. The number and nature of similar marks in use on similar goods or services;

7. The lack of any concurrent use without evidence of actual confusion; and

8. Other considerations.

Applicant respectfully submits that after a careful analysis of the *Du Pont* factors, this Board will conclude that each of the factors weights in favor of Applicant and that registration is proper.

1. Dissimilarity of the Marks

Dissimilarity of the marks is determined by comparing the marks in their entirety as to appearance, sound, connotation and commercial impression. *Du Pont* at 567. When comparing the two marks, it is imperative to look at the overall impression created by the marks and not merely compare individual features. The use of identical words is often insufficient to conclude that marks are confusingly similar. *General Mills, Inc. v. Kellogg Co.*, 3 U.S.P.Q.2d 1442 (8th Cir. 1987); *See, Consolidated Cigar Corp. v. R.J. Reynolds Tobacco Co.*, 181 U.S.P.Q. 44 (C.C.P.A. 1974) (finding that DUTCHMASTERS and DUTCHAPPLE are not confusingly similar); *see also, Colgate-Palmolive Co. v. Carter Wallace, Inc.*, 167 U.S.P.Q. 529 (C.C.P.A. 1970) (finding that PEAK and PEAK PERIOD are not confusingly similar); *see also, Smith v. Tobacco By-Products and Chemical Corp.*, 113 U.S.P.Q. 339 (C.C.P.A. 1957) (finding that GREENLEAF and BLACKLEAF are not confusingly similar).

In articulating reasons for reaching the conclusion on the issue of confusion, the examining attorney may state that, for rational reasons, more or less weight has been given to a particular feature of a mark. However, the ultimate conclusion rests on consideration of the marks in their entireties. *In re National Data Corp.*, 224 U.S.P.Q. 749, 750-51 (Fed. Cir. 1985).

In terms of appearance, Applicant's mark does not resemble the registered mark. As the Examining Attorney has recognized, Applicant has applied to register the mark NORTHBROOK BANK & TRUST COMPANY not the mark "Northbrook." Applicant respectfully submits that not only is there a phonetic and visual distinction between NORTHBROOK BANK & TRUST COMPANY as that mark is used in Applicant's mark and the mark "Northbrook" as used in the registered mark. These differences in appearance and pronunciation make confusion unlikely. Clearly, a purchaser viewing the marks would see that the subject mark looks quite unlike the cited mark. As a result, the subject mark leaves a completely different impression in the minds of the purchasers than does the cited mark. This makes sense. After all, the subject mark indicates that the services that will be offered under it derive from Applicant. Meanwhile, the cited mark indicates that the services offered under it derive from Registrant.

In terms of commercial impression, Applicant's mark is suggestive and wholly different from the registered mark such that there is no likelihood of confusion. The whole, in trademark law, is often greater than the sum of its parts. Common words in which no one may acquire a trademark because they

are descriptive or generic may when used in combination, become a valid trademark. *Association of Co-operative Members, Inc. v. Farmland Industries, Inc.*, 216 U.S.P.Q. 361 (5th Cir. 1982), quoted with approval in *Taco Cabana Int'l, Inc. v. Two Pesos, Inc.*, 19 U.S.P.Q.2d 1253, 1258 (5th Cir. 1991), *aff'd*, 23 U.S.P.Q.2d 1091 (1992) (combination of descriptive elements of trade dress can itself be inherently distinctive: "[T]he existence of descriptive elements does not eliminate the possibility of inherent distinctiveness in the trade dress as a whole.").

Further, a geographical term combined with other elements to form a composite mark results in a combination that often does not have any descriptive connotations. The total commercial impression created by a composite mark is often merely arbitrary or suggestive even though its separate parts may be geographically descriptive. A composite mark should not be fragmented into its various pieces. *Estate of P. D. Beckwith, Inc., v. Commissioner of Patents*, 252 U.S. 538, 64 L. Ed. 705, 40 S. Ct. 414 (1920). It is the likely reaction of customers to the total mark that is at issue, not the dissected parts. *In re Standard Elektrik Lorenz Aktiengesellschaft*, 152 U.S.P.Q. 563 (C.C.P.A. 1967). See *Ex Parte Maya de Mexico*, 103 U.S.P.Q. 158 (Comm'r Pat. 1954).

Applicant respectfully traverses the Examining Attorney's assertion that similarity in either sound, appearance, meaning or commercial impression alone is sufficient to find a likelihood of confusion. The case cited by the Examiner, *In re Mack*, 197 U.S.P.Q. 755 (T.T.A.B. 1977), does not support for

such proposition. Rather, other likelihood of confusion factors must also be evaluated before drawing any such conclusion. Applicant respectfully requests this Board to note the above cited cases in which identical or nearly identical marks were registered as a result of lack of likelihood of confusion.

Moreover, the cited registration is registered on the Supplemental Register. As a result thereof, the scope of protection accorded such a registration is significantly narrowed and limited such that likelihood of confusion can only be found where the marks are nearly identical as with respect to the marks and the services provided in connection therewith. *In re Smith and Mehaffey*, 31 U.S.P.Q.2d 1531 (T.T.A.B. 1994). In the subject application, the marks are sufficiently different to avoid a likelihood of confusion as discussed above.

Therefore, Applicant respectfully submits that this factor weighs heavily in favor of Applicant since it is clear from the facts and case law above that Applicant's mark NORTHBROOK BANK & TRUST COMPANY is sufficiently different than the cited mark as to appearance, sound, connotation and commercial impression, as to avoid a likelihood of confusion.

2. Dissimilarity of the Services

The marks and/or services of the parties need to be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods or services come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 223 U.S.P.Q. 1289 (Fed. Cir.

1984). The question is not whether the public will confuse the marks, but whether the marks will confuse the public into believing the products emanate from the same source. *Paula Payne Prods. Co. v. Johnson Publishing Co.*, 177 U.S.P.Q. 76 (C.C.P.A. 1973); *In re Amsted Indus., Inc.*, 24 U.S.P.Q.2d 1067 (Fed. Cir. 1998). The test is whether the products are the kind that the public attributes to a single source. *McGraw-Edison Co. v. Walt Disney Production*, 225 U.S.P.Q. 512 (7th Cir. 1985).

Applicant respectfully traverses the Examining Attorney's inference that Applicant's services are related to Registrant's services such that each of the services may travel in the same channels of trade. Further, the Examining Attorney's reliance on the repeal of the 1939 Glass-Steagal Act is wholly unfounded. Applicant is unaware of and the Examining Attorney has failed to provide a showing that the TTAB or the Federal Circuit have held in a published opinion that the repeal of the 1939 Glass-Steagal Act creates a presumption that banking services and insurance services are so highly related as to be nearly identical, as the Examining Attorney asserts.

Applicant notes that banking services are not present in any of the recitations of services of the cited registrations. Further, the Examining Attorney has failed to make satisfactory showing that Registrant is licensed to provide banking services. Hence, Applicant must conclude that Registrant is barred at law from providing banking services. Accordingly, Registrant cannot provide banking services and will not be viewed by the public as a source of banking services in the same channels of trade as Applicant's services.

Further, the Examining Attorney fails to provide a satisfactory showing that such a peripheral relationship between banking services and insurance services could give rise to the mistaken belief that the services emanate from a common source. The third party registrations are not probative as a determination of likelihood of confusion analysis between the cited registration and the subject application for the reasons below.

Applicant contends that its services and the Registrant's services are not so related as to cause confusion. Where the services are non-competing, the degree of similarity necessary to establish likelihood of confusion increases dramatically. *David Sherman Corp. v. Heubein, Inc.*, 144 U.S.P.Q. 249 (8th Cir. 1965). Cases where courts have found likelihood of confusion between two non-competing goods, the relationship between the products was clear. *James Burrough Ltd. v. Sign of the Beefeater, Inc.*, 192 U.S.P.Q. 555 (7th Cir. 1976)(liquor with restaurant selling liquor); *Union Carbide Corp. v. Ever-Ready, Inc.*, 188 U.S.P.Q. 623 (7th Cir. 1976)(batteries and lamps with light bulbs and lamps); *Scarves by Vera, Inc., v. Todo Imports, Ltd.*, 192 U.S.P.Q. 289 (2d Cir. 1976)(women's scarves and apparel with women's cosmetics and fragrances).

Applicant respectfully submits that the relationship between the services provided by the Applicant and the non-competing services provided by Registrant is not clear. The nature and scope of Registrant's services must be determined on the basis of the services set forth in the registration, not in third party registrations. See, e.g., Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, 1 U.S.P.Q.2d 1813 (Fed. Cir. 1987); *Paula Payne Products*

Co. v. Johnson Publishing Co., 177 U.S.P.Q. 76 (C.C.P.A. 1973). Banking services and insurances are not clearly related on their face. It is also not clear that Registrant will ever participate in providing banking services similar to those offered by the Applicant. Furthermore, Registrant is barred by law from providing such services as discussed above. Finally, the Examining Attorney has failed to provide a showing that Registrant can or intends to provide banking services in the future. Even though there may a remote possibility that the Registrant may in the future time provide banking services in addition to the insurance services now provided, at this time, Registrant does not even "intimate such a purpose." See, *S.C. Johnson & Sons, Inc. v. Johnson*, 175 F.2d 176, 180 (2d Cir. 1949)(No confusion was found between floor wax and cleaner and furniture polish with brooms and mops: "Although the Plaintiff may at some future time wish to make cleaning fluids, it does not now even intimate such a purpose.").

Moreover, Applicant's services are sufficiently different from the cited registration to avoid a likelihood of confusion because the cited registration is on the Supplemental Register. As a result thereof, the scope of protection accorded such a registration is significantly narrowed such that likelihood of confusion is only found where the services are nearly identical with respect to the marks and the services provided in connection therewith. *In re Smith and Mehaffey*, 31 U.S.P.Q.2d 1531 (T.T.A.B. 1994). Accordingly, the only conclusion this Board can draw is that the services of Applicant and Registrant are

sufficiently different such that a finding of likelihood of confusion cannot be supported.

Therefore, Applicant respectfully submits that this factor weighs heavily in favor of Applicant since it is clear from the facts and case law above that Applicant's services are significantly different than those recited in the cited registration as to avoid a likelihood of confusion.

Moreover, several of the cited registrations are directed to commercial products which travel in different trade channels to different purchasers and banking services available to the public.

3. Dissimilarity of Trade Channels

As discussed above, Registrant is barred by law from providing banking services. Accordingly, the services of the cited registrations cannot legally travel through the same channels of trade as the Applicant's services. Further, as discussed above, Registrant does not "intimate such a purpose" of providing banking services in the future. The Examining Attorney has failed to provide a satisfactory showing that Registrant is entitled to provide banking services other than an over-generalized reference to the repeal of the 1939 Glass-Steagal Act. Reliance on such an act of Congress and actions of other third parties is irrelevant with regards to registration. *See e.g., Canadian Imperial; Paula Payne.* Additionally, the Examining Attorney has failed to provide any evidence that Registrant has filed for or has been granted authorization to provide banking services or that Registrant is considering such a request.

Therefore, Applicant respectfully submits that this factor weighs heavily in favor of Applicant since it is clear from the facts and case law above that Applicant's services travel in sufficiently different channels of trade than those recited in the cited registration as to avoid a likelihood of confusion.

4. Conditions Under Which Sales are Made

The purchasers of both the Applicant's and Registrant's services are sophisticated and well-informed. When there is a decision made by a sophisticated, well-informed purchaser and the decision concerns an expensive product or service, or is made after careful examination of the service, it may be sufficient to negate a likelihood of confusion even between marks of great similarity. *In re Software Design, Inc.*, 220 U.S.P.Q. 662 (T.T.A.B. 1983); *Litton Sys., Inc. v. Whirlpool Corp.*, 221 U.S.P.Q. 97 (Fed. Cir. 1984). Applicant respectfully submits that such sophisticated, well-informed purchasers of expensive products or services are also in fact sophisticated and knowledgeable in the field of trademarks such that they are immune from source confusion.

Applicant contends that the conditions under which banking services and insurances services are provided do not fall into an "impulse" category. Rather each service is obtained after careful and detailed analysis. Purchasing decisions made with respect to savings accounts, mortgages, auto loans, home equity loans, checking accounts and money market savings accounts all involve paperwork and information disclosure. Each transaction or purchasing decision requires a sufficient amount of paperwork and the value to the purchasers is very high such that it is more than reasonable to conclude that

the purchasers decision will be well-informed and carefully thought out. Obviously, well-informed and sophisticated purchasers of banking services would be knowledgeable not only of the source of their banking services, but also the trademark under which the preferred banking services are provided.

Similarly and to a more extensive degree, insurance services require a considerable amount of careful thought, preparation, review of paperwork and disclosure of information such that a great deal of care is exercised. Consumers acquire a certain degree of sophistication in accomplishing these tasks. Therefore, it also obvious that well-informed and sophisticated purchasers of insurance services would have considerable knowledgeable and familiarity not only with the source of the insurance services, but also the trademarks under which the services are provided. Moreover, the purchasing public must be credited with a modicum of intelligence. *Carnation Company v. California Growers*, 37 U.S.P.Q. 735, 736 (C.C.P.A. 1938).

Accordingly, Applicant respectfully submits that it would be strange for sophisticated, well-informed customers of these disparate services to be confused about whom they are dealing with. *Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, 6 U.S.P.Q.2d 1305 (Fed. Cir. 1988); *Cohn v. Petsmart, Inc.*, 61 U.S.P.Q.2d 1688 (9th Cir. 2002).

Therefore, Applicant respectfully submits that this factor weighs heavily in favor of Applicant since it is clear from the facts and case law above that the purchasers of banking services and insurances services are both sophisticated and careful enough such that a likelihood of confusion is highly improbable.

5. Lack of Fame

The Examining Attorney has failed to provide any evidence that the cited registration is entitled to any deference with regard to fame. Accordingly, Applicant must conclude that the cited registration is not famous and must be accorded a limited scope of protection. As per the evidence of the limited scope of protection, Applicant again refers to the decision in *In re Smith and Mehaffey*, in which the court held that for marks on the Supplemental Register likelihood of confusion has been found only where the marks and goods are nearly identical. 31 U.S.P.Q.2d at 1533.

Therefore, Applicant respectfully submits that this factor weighs heavily in favor of Applicant since it is clear from the facts and case law above that the cited registration is entitled to only a limited, narrow scope of protection such that slight differences between the cited marks and Applicant's subject mark are sufficient to avoid a likelihood of confusion.

6. Similar Marks in Use

Applicant respectfully submits that the cited marks are extremely weak. As evidence of such weakness and the extremely limited scope, Applicant submitted two (2) pages from a Thomson & Thomson search report directed to common law use of the expression "Northbrook" in connection with banking, investment, financial and insurance services. Please note Exhibit A submitted with Applicant's response dated June 5, 2002. Furthermore, Applicant also provided two (2) pages from the local telephone directory covering the Northbrook, Illinois area which lists numerous other common law uses of the

"Northbrook" expression by providers of goods and services which incorporate the name of the city Northbrook in the business' name to indicate the source of such goods and/or services. Please note Exhibit B submitted with Applicant's response dated June 5, 2002. Applicant respectfully submits that residents in Northbrook, Illinois are knowledgeable about whom they are dealing with and are not confused by the numerous uses of the geographic expression "Northbrook" in connection with various different goods and services. The source of such goods and services is obviously emanating from the Northbrook, Illinois area and more specifically from the descriptive expressions used to identify the exact goods or services.

As a result, use of the expression "Northbrook" is not unique. Further, Registrant is not the sole source for goods or services provided in connection with the "Northbrook" expression. Accordingly, the cited registration on the Supplemental Register is of such limited, narrow scope of protection that Applicant's mark is sufficient dissimilar to avoid confusion.

Therefore, Applicant respectfully submits that this factor weighs heavily in favor of Applicant since it is clear from the facts and case law above that the cited registration is entitled to only a limited, narrow scope of protection such that slight differences between the cited mark and Applicant's subject mark are sufficient to avoid a likelihood of confusion.

7. Actual Confusion

Applicant respectfully submits that its NORTHBROOK BANK & TRUST COMPANY mark has been in use in commerce since on or before November 22,

2000 in connection with providing banking services in the area of Northbrook, Illinois. Applicant is aware of no instance in which a customer or potential customer has come into Applicant's NORTHBROOK BANK & TRUST COMPANY bank seeking to obtain insurance coverage from "Northbrook." The Examiner has failed to provide any evidence of actual confusion.

Therefore, Applicant respectfully submits that this factor weighs heavily in favor of Applicant since it is clear from the facts and case law above that the cited registration is entitled to only a limited, narrow scope of protection such that slight differences between the cited mark and Applicant's subject mark are sufficient to avoid a likelihood of confusion and that there have been no instance of actual confusion.

8. Other Considerations

Applicant respectfully submits that the cited Registration is so weak as to preclude any likelihood of confusion. Weak marks are entitled to protection against subsequent registration where the junior mark is nearly identical and the goods or services are competitive. *A.H. Robins Co. v. Evsco Pharmaceutical Corp.*, 190 U.S.P.Q. 340 (T.T.A.B. 1976); *In re Maaco Mfg.* 192 U.S.P.Q. 573 (T.T.A.B. 1976); *In re Bayuk Cigars, Inc.*, 197 U.S.P.Q. 627 (T.T.A.B. 1997). Determining that a mark is weak means that consumer confusion has been found unlikely because the mark's components are so widely used that the public can easily distinguish slight differences in the marks, even if the goods or services are related. *General Mills, Inc. v. Kellogg Co.*, 3 U.S.P.Q.2d 1442 (8th

Cir. 1987). Accordingly, highly descriptive or laudatory marks are weak and given only a narrow range of protection.

Applicant respectfully submits that the cited registration is sufficiently different and the "Northbrook" expression is so widely used that consumers can easily distinguish Applicant's mark as the source of Applicant's services from Registrant's marks as the source of Registrant's services. As a result, there can be no likelihood of confusion. Further, for the buyer to be deceived, he must be looking for something. *Spangler Candy Co. v. Crystal Pure Candy Co.*, 143 U.S.P.Q. 94 (N.D. Ill. 1964), *aff'd.*, 147 U.S.P.Q. 434 (7th Cir. 1965). Accordingly, Applicant respectfully submits that, based upon the facts above, purchasers would not be confused as to the source of the services or that they would be looking for such services on the basis of the "Northbrook" expression as use of such expression is so common.

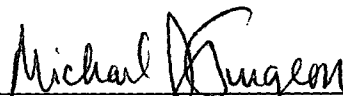
Finally, the USPTO has historically registered marks having identical nouns and adjectives to different entities for banking and insurance services. Applicant submitted substantial evidence directed to this fact in responses filed with the USPTO dated January 9, 2001 and June 5, 2002. The evidence is the result of searches performed by Applicant on the USPTO's TESS on-line database available over the Internet. Applicant respectfully requests that this Board note such evidence.

IV. CONCLUSION

For all the foregoing reasons, Applicant submits that the Examining Attorney's refusal should be reversed and the application to register this mark should be passed to publication.

Respectfully submitted,

VEDDER, PRICE, KAUFMAN & KAMMHOLZ

A handwritten signature in dark ink, appearing to read "Michael J. Turgeon", is written over a horizontal line.

Michael J. Turgeon, #39,404
One of Applicant's Attorneys

Dated: August 5, 2002

222 North LaSalle Street
24th Floor
Chicago, Illinois 60601-1003
312/609-7716

40 S.Ct. 414
64 L.Ed. 705
(Cite as: 252 U.S. 538, 40 S.Ct. 414)

▷

Supreme Court of the United States

ESTATE OF P. D. BECKWITH, Inc.,

v.

COMMISSIONER OF PATENTS.

No. 178.

Argued and Submitted Jan. 23, 1920.

Decided April 19, 1920.

On Writ of Certiorari to the Court of Appeals of the District of Columbia.

Application in the Patent Office for the registration of a trade-mark by the Estate of P. D. Beckwith, Incorporated. A decision of the Commissioner of Patents, granting registration on conditions, was affirmed by the Court of Appeals for the District of Columbia (48 App. D. C. 110), and the petitioner brings certiorari. Reversed.

West Headnotes

Trade Regulation ⚡13

382k13 Most Cited Cases

The law will not secure to any person the exclusive use of a trade-mark, consisting merely of words descriptive of the qualities, ingredients, or characteristics of an article of trade.

Trade Regulation ⚡15

382k15 Most Cited Cases

The words "Moistair Heating System" are descriptive, as applied to heaters and furnaces claimed to impart moisture to the air in the process of heating.

Trade Regulation ⚡162.1

382k162.1 Most Cited Cases

(Formerly 382k162)

Trade Regulation ⚡164

382k164 Most Cited Cases

Under Act Feb. 20, 1905, § 5, as amended by Act Jan. 8, 1913 (see 15 U.S.C.A. § 85), providing that

no trade-mark shall be refused registration as a trade-mark on account of its nature, unless it consists of certain prohibited matter, provided that no mark which consists "merely" in descriptive words or devices shall be registered, a trade-mark consisting of descriptive words used in a described manner of association with nondescriptive words and as a definitely positioned part of an entirely fanciful and arbitrary design or seal, cannot be denied registration when accompanied by a disclaimer of the descriptive words except in the precise relation and association in which they appear, nor can elimination of such descriptive words, thereby changing the mark as previously used, be required as a condition of registration.

Trade Regulation ⚡736

382k736 Most Cited Cases

Moistair Heating System.

****414 *539** Mr. Harry C. Howard, of Kalamazoo, Mich., for petitioner.

Mr. Assistant Attorney General Davis, for respondent.

Mr. Justice CLARKE delivered the opinion of the Court.

The petitioner, a corporation, filed an application in the Patent Office for the registration of a trade-mark, which is described as follows:

'A design like a seal, comprising the head of an Indian chief surmounting a scroll bearing his name, 'Doe-Wah-Jack' and surrounded by a circle, outside of which appeared the words 'Round Oak' and 'Moistair Heating System' in acircle, and the whole being surrounded by a wreath of oak leaves.'

It will be useful to reproduce the drawing filed with this application:

40 S.Ct. 414
64 L.Ed. 705
(Cite as: 252 U.S. 538, 40 S.Ct. 414)



****415** It was averred that the petitioner had used the mark for more than 18 months before the application ***540** was made by applying it to 'hot-air and combined hot-air and hot-water heaters and furnaces by having the same cast into the metals of which the systems were constructed.'

The Commissioner found that the mark did not conflict with any other that was registered, and that the petitioner was entitled to the exclusive use of it excepting the words 'Moistair Heating System.' It was ordered that the mark might be registered if the excepted words, objectionable because descriptive, were 'erased' or 'removed' from it, but that the filing of a disclaimer would not suffice to secure registration.

Not satisfied with this result, the petitioner appealed to the Court of Appeals for the District of Columbia, and its judgment affirming the decision of the Commissioner of Patents is before us for review.

The ground of both decisions is that the words 'Moistair Heating System' are merely descriptive of a claimed merit of the petitioner's system--that in the process of heating moisture is added to the air--and that one person may not lawfully monopolize the use of words in general use which might be used with equal truthfulness to describe another system of heating. For this reason it was held that the case falls within the proviso of the Registration Act of 1905, declaring that no mark consisting merely in words or devices which are descriptive of the goods with which they are used or of the character or quality of such goods shall be registered under the terms of the act. Act Feb. 20, 1905, § 5, 33 Stat. 725, amended by Act Jan. 8, 1913, 37 Stat. 649 (Comp. St. § 9490).

No question of patent right, or of unfair

competition, or that the design of the trade-mark is so simple as to be a mere device or contrivance to evade the law and secure the registration of non-registrable words, is involved. *Naim Linoleum Co. v. Ringwalt Linoleum Works*, 46 App. D. C. 64, 69.

***541** This statement makes it apparent that the question presented for decision is: Whether the applicant may lawfully register the words 'Moistair Heating System,' when combined with the words 'Round Oak,' as a part of its purely fanciful and arbitrary trade-mark design, as shown in the drawing filed, and when claim to exclusive use of the words apart from the mark shown in the drawing is disclaimed on the record.

An account of the process of decision, in the Patent Office and in the Court of Appeals, by which the result in this case was arrived at, as it appears in the brief of the Commissioner of Patents, is suggestive and useful. From this we learn that, when a mark has been presented for registration consisting merely (only) of descriptive words or devices, registration has been uniformly refused. When 'composite' marks--such as contain both registrable and nonregistrable matter--have been presented for registry with features in them which conflicted with earlier marks, registered by other than the applicant, the complete rejection, 'eradication,' of the conflicting portions has been uniformly required before registry was allowed. But where there was no such conflict, and the only objection was that descriptive words were used, the practice of the Patent Office prior to the decision, in 1909, of *Johnson v. Brandau*, 32 App. D. C. 348, was to permit the registration of marks containing such words, where they were associated with registrable words or were a part of an arbitrary or fanciful design or device; it being considered not necessary to delete the descriptive matter, even when it was an essential part of the composite trade-mark as it had been used by the applicant, provided it was clearly not susceptible of exclusive appropriation under the general rules of law. After the decision of *Johnson v. Brandau*, 32 App. D. C. 348, a practice grew up in the Patent Office, not provided for in the statute, of allowing an applicant to disclaim objectionable descriptive ***542** words in cases where to require their actual removal would result in so changing the mark that it would not readily be recognized as that shown in the drawing or specimen filed with the

40 S.Ct. 414
64 L.Ed. 705
(Cite as: 252 U.S. 538, 40 S.Ct. 414)

application. The customary form of such disclaimer was a statement filed that no claim was made to the designated words, as, for example, 'Moistair Heating System,' apart from the mark shown in the drawing--this was interpreted as meaning that only when taken in connection with the remaining features of the mark did the applicant make claim to their exclusive use. Ex parte Illinois Seed Co., 219 O. G. 931.

Such disclaimer became a part of the applicant's statement in the record and necessarily formed a part of the certificate of registration as it would appear in the copies of it furnished to the applicant and the public, pursuant to section 11 of the act (Comp. St. § 9496).

Then came the decisions in Fishbeck Soap Co. v. Kleeno Manufacturing Co., 44 App. D. C. 6, and Nairn Linoleum Co. v. Ringwalt Linoleum Works, 46 App. D. C. 64, which, says the Commissioner of Patents, were understood as disapproving the practice of disclaimer, and since they were rendered, registration of merely descriptive matter has not been allowed in any form, but its actual deletion from the trade-mark drawing has been required, with, however, an apparent exception in the Case of Rinsburger, 8 T. M. Repts. 567, 128 MS. Dec. 141. The judgment we are considering, requiring, as it does, the 'elimination' of the descriptive words, shows that the Commissioner correctly interpreted these two decisions of the Court of Appeals.

It is apparent from this rehearsal that the Commissioner of Patents has promptly and cordially accepted for his guidance the decisions **416 of the Court of Appeals, and, although he avoids a controversial attitude in his brief and gives a colorless history of the practice of his office, *543 still it is manifest that, in this case and in others, the court has very radically changed that practice with respect to permitting registry of composite trade-marks, and that its decisions have turned upon the construction of the second proviso, referred to, in the fifth section of the Registration Act, which is made the basis of the judgment we are reviewing.

The Registration Act of 1905 (33 Stat. 724), amended in 1906 (34 Stat. 168) and in 1909 (35 Stat. 627) and in 1913 (37 Stat. 649 [Comp. St. § 9485 et seq.]), without changing the substantive law

of trade-marks, provided, in the manner prescribed, for the registration of marks (subject to special exceptions) which, without the statute, would be entitled to legal and equitable protection, and the case before us calls chiefly for the construction of the provisions of section 5 of that act (Comp. St. § 9490), which, so far as here involved, are as follows:

'No mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark unless,' etc.

'Provided, that no mark which consists * * merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, * * * shall be registered under the the terms of this act.'*

[1] It was settled long prior to the Trade-Mark Registration Act that the law would not secure to any person the exclusive use of a trade-mark consisting merely of words descriptive of the qualities, ingredients, or characteristics of an article of trade; this for the reason that the function of a trade-mark is to point distinctively, either by its own meaning or by association, to the origin or ownership of the wares to which it is applied, and words merely descriptive of qualities, ingredients, or characteristics, when used alone, do not do this. Other like goods, equal to them in all respects, may be manufactured or *544 dealt in by others, who, with equal truth, may use, and must be left free to use, the same language of description in placing their goods before the public. Canal Co. v. Clark, 13 Wall. 311, 322, 323, 324, 20 L. Ed. 581; Manufacturing Co. v. Trainer, 101 U. S. 51, 54, 25 L. Ed. 993; Manhattan Medicine Co. v. Wood, 108 U. S. 218, 222, 2 Sup. Ct. 436, 27 L. Ed. 706; Goodyear India Rubber Glove Mfg. Co. v. Goodyear Rubber Co., 128 U. S. 598, 9 Sup. Ct. 166, 32 L. Ed. 535; Lawrence Manufacturing Co. v. Tennessee Manufacturing Co., 138 U. S. 537, 547, 11 Sup. Ct. 396, 34 L. Ed. 997; Brown Chemical Co. v. Meyer, 139 U. S. 540, 11 Sup. Ct. 625, 35 L. Ed. 247; Elgin National Watch Co. v. Illinois Watch Case Co., 179 U. S. 665, 21 Sup. Ct. 270, 45 L. Ed. 365; Standard Paint Co. v. Trinidad Asphalt Mfg. Co., 220 U. S. 446, 31 Sup. Ct. 456, 55 L. Ed. 536.

[2][3] Thus the proviso quoted, being simply an

40 S.Ct. 414
 64 L.Ed. 705
 (Cite as: 252 U.S. 538, 40 S.Ct. 414)

expression in statutory form of the prior general rule of law that words merely descriptive are not a proper subject for exclusive trade-mark appropriation, if the application in this case had been to register only the words 'Moistair Heating System,' plainly it would have fallen within the terms of the prohibition, for they are merely descriptive of a claimed property or quality of the petitioner's heating system--that by it moisture is imparted to the air in the process of heating. But the application was not to register these descriptive words 'merely,' alone and apart from the mark shown in the drawing, but in a described manner of association with other words, 'Round Oak,' which are not descriptive of any quality of applicant's heating system, and as a definitely positioned part of an entirely fanciful and arbitrary design or seal, to which the Commissioner found the applicant had the exclusive right.

Since the proviso prohibits the registration not of merely descriptive words but of a 'trade-mark which consists * * * merely' (only) of such words--the distinction is substantial and plain--we think it sufficiently clear that such a composite mark as we have here does not fall within its terms. In this connection it must be noted that the requirement of the statute that *545 no trade-mark shall be refused registration, except in designated cases, is just as imperative as the prohibition of the proviso against registration in cases specified.

While there is no specific provision for disclaimers in the trade-mark statute, the practice of using them is commended to our judgment by the statement of the Commissioner of Patents that, so far as known, no harm came to the public from the practice of distinguishing, without deleting, nonregistrable matter in the drawing of the mark as registered, when a statement, forming a part of the record, was required that the applicant was not making claim to an exclusive appropriation of such matter except in the precise relation and association in which it appeared in the drawing and description.

It seems obvious that no one could be deceived as to the scope of such a mark, and that the registrant would be precluded by his disclaimer from setting up in the future any exclusive right to the disclaimed part of it. It seems obvious, also, that to require the deletion of descriptive words must result often in so changing the trade-mark sought to be

registered from the form in which it had been used in actual trade that it would not be recognized as the same mark as that shown in the drawing which the statute requires to be filed with the application, or in the specimens produced as actually used, and therefore registration would lose much, if not all, of its **417 value. The required omission might so change the mark that in an infringement suit it could be successfully urged that the registered mark had not been used,--and user is the foundation of registry. Section 2 (Comp. St. § 9487). Of this last the case before us furnishes an excellent example. To strike out 'Moistair Heating System' from the applicant's trade-mark would so change its appearance that its value must be largely lost as designating to prior purchasers or users the origin of the heating system to which it was applied.

The commercial impression of a trade-mark is derived *546 from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety (Johnson v. Brandau, supra), and to strike out any considerable part of it, certainly any conspicuous part of it, would be to greatly affect its value. Of course, refusal to register a mark does not prevent a former user from continuing its use; but it deprives him of the benefits of the statute, and this should not be done if it can be avoided by fair, even liberal, construction of the act, designed as it is to promote the domestic and foreign trade of our country.

Thus the case comes to this: That the Commissioner found that the trade-mark presented for registration did not conflict with any theretofore registered, and there is no suggestion of unfair practice in the past or contemplated in the future; that it had been used for 18 months in the form proposed for registry; that the words ordered to be stricken out from the drawing are descriptive, but the mark does not consist 'merely' in such words, but is a composite of them with others, and with an arbitrary design which, without these words, both the Commissioner and the court found to be registrable; that the language of the statute, that no mark not within its prohibitions or provisos shall be denied registration, is just as imperative as the prohibitory words of the proviso; and, very certainly, that a disclaimer on the part of applicant that no claim is made to the use of the words 'Moistair Heating System' apart from the mark as shown in the drawing and as described, would

40 S.Ct. 414
64 L.Ed. 705
(Cite as: 252 U.S. 538, 40 S.Ct. 414)

preserve to all others the right to use these words in the future to truthfully describe a like property or result of another system, provided only that they be not used in a trade-mark which so nearly resembles that of the petitioner 'as to be likely to cause confusion in the mind of the public or to deceive purchasers' when applied 'to merchandise of the same descriptive properties.' Section 5.

*547 Such being the ultimate facts of this controversy, we cannot doubt that the Court of Appeals fell into error in ruling that the words 'Moistair Heating System' must be 'eliminated' from the trade-mark of the applicant as it had been theretofore used, and that the requirement of the act of Congress for the registration of trade-marks would be fully complied with if registration of it were permitted with an appropriate declaration on the part of the applicant that no claim is made to the right to the exclusive use of the descriptive words, except in the setting and relation in which they appear in the drawing, description, and samples of the trade-mark filed with the application.

It results that the judgment of the Court of Appeals must be

Reversed.

Mr. Justice McREYNOLDS dissents.

40 S.Ct. 414, 252 U.S. 538, 64 L.Ed. 705

END OF DOCUMENT